

REMARKS

Claims 1 – 5 are pending in the instant patent application.

Claims 1 – 2 and 4 are rejected under 35 U.S.C. § 103 as being unpatentable over eSpeed (eSpeed Signs Deals with 7 Online Brokers to Give Consumers the Ability to Trade Bonds the Same Way They Trade Stocks. PR Newswire. New York, May 15, 2000, p.1) in view of ClearCHOICE (BNY ESI & Co. Launches ClearCHOICE (SM). PR Newswire. New York. October 5, 1998. p.1). The Office Action asserts that eSpeed discloses a first computer, a second computer for performing middle and back office processing, a communication channel for communicating between the first and second computers, where the first computer is a client computer and where the communication channel is the Internet, and the interface is a browser. The Office Action admits that eSpeed does not disclose a first computer having an interface for capturing executed trade data, a second computer for accepting the captured trade data, or a communication channel for communicating the captured trade data between the first and second computers. The Office Action further asserts that ClearCHOICE discloses a first computer having an interface for capturing executed trade data.

Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over eSpeed in view of Richards (US Patent 5,003,473). The Office Action asserts that Richards teaches a first computer having an interface transmitting electronic trade tickets and a second computer for receiving the electronic trade tickets.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. 2143.03 citing *In re Royka*, 490 F.2d 981 (CCPA 1974). A finding of obviousness under 35 U.S.C. § 103(a) requires a determination that the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. Deere*, 383 U.S. 1 (1966). The relevant inquiry is whether the prior art suggests the invention

and whether the prior art provides one of ordinary skill in the art with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be found in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Applicants submit that the combinations of eSpeed with ClearCHOICE or eSpeed with Richards do not disclose each and every element of the claimed invention and respectfully request the withdrawal of the rejection for the following reasons.

The Office Action admits that eSpeed does not disclose a first computer having an interface for capturing executed trade data, a second computer for accepting the captured trade data, or a communication channel for communicating the captured trade data between the first and second computers. Furthermore, the only support for asserting that ClearCHOICE discloses a first computer having an interface for capturing executed trade data is the single phrase, "ClearCHOICE offers users the ability to eliminate information leakage by efficiently capturing trade data within our straight-through processing system." The ClearCHOICE reference does not even mention a first computer or a second computer nor does it teach an interface on the first computer for capturing executed trade data. The ClearCHOICE reference does not teach a first computer having an interface for capturing executed trade data, a second computer for accepting the captured trade data, or a communication channel for communicating the captured trade data between the first and second computers.

Applicants respectfully submit that the combination of eSpeed with ClearCHOICE does not teach every claim limitation of independent claim 1 and a *prima facie* case for obviousness has not been made. Furthermore, claims 2 – 4 depend on independent claim 1 and include all the limitations of claim 1. Applicants submit that claims 2 – 4 are in condition of allowance because claim 1 is allowable.

The amendments to claim 5 obviate the rejection of claim 5. The Office Action asserts that col. 2, lines 25 – 35 of Richardson teaches establishing the transmission of electronic trade tickets and a second computer for receiving the electronic trade ticket. Richardson teaches a local database server 416 that provides a back office computer

401 records of the tickets generated by the keystations associated with the terminal controller 400, and a conversation analysis server 418. (Richardson, col. 5, lines 31 – 35.) The analysis server 418 provides dealing tickets to the local database server 416. Neither the analysis server 418 nor the local database server 416 is a client computer as required in amended claim 5.

Applicants respectfully submit that the rejections of claims 1 – 5 under 35 U.S.C. § 103 have been overcome. Applicants respectfully request that the rejections be withdrawn.

Applicants request entry of the foregoing amendments and remarks into the file history of the above-identified application. Applicants believe that each ground for rejection has been successfully overcome and/or obviated, and that all pending claims are in condition for allowance. Withdrawal of the rejections and allowance of the application are respectfully requested.

No fee is believed to be due in connection with filing of the instant request. However, if a fee is due, please charge the required fee to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310.

Respectfully submitted,

Date: August 24, 2005



Steven K. Fukuda (Reg. No. 44,690)

Customer No.: **09629**

Morgan, Lewis & Bockius LLP
101 Park Avenue
New York, NY 10178-0060
212.309.6000